No. 02-428

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In The

Supreme Court of the United States

DASTAR CORPORATION,

Petitioner,

v.

TWENTIETH CENTURY FOX FILM CORPORATION, et al.,

Respondents.

On Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

BRIEF *AMICI CURIAE* OF INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF PETITIONER

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Petition for Certiorari, *Dastar v. Twentieth Century Fox Film Corp.*, No. 02-428 (U.S. S.Ct. filed Sept. 11, 2002), App. C 14

INTERESTS OF *AMICI CURIAE*

This brief *amici curiae* is submitted pursuant to Rule 37 of the Rules of this Court.[1]

Amici are law professors and scholars specializing in trademark, copyright, and related subjects. *Amici* do not have any financial interest in the outcome of this litigation. *Amici* are listed in the Appendix to this brief and provide their institutional affiliation for identification purposes only; they do not purport to represent the opinions or interests of their respective institutions. *Amici*'s sole interest is in fostering the development of intellectual property law generally, and of trademark and copyright law in particular, in accordance with established legal principles.

SUMMARY OF ARGUMENT

Beginning more than 100 years ago, former owners of expired copyrights have attempted to use trademark and unfair competition laws to prevent or impair the free use of works in the public domain. These attempts took the form of suits seeking to prevent the use of the work, or of the author's name or the title of the work, in any republication or revised edition of a public domain work. These

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[1] Counsel for both parties have consented to the filing of this brief, and those consents have been filed with the Clerk of this Court. No counsel for either party authored this brief in whole or in part. The entire cost of preparing and submitting the brief was paid by *amici*, with the generous support of Whittier Law School.

attempts were properly rejected by the courts, including the U.S. Supreme Court. In some instances, however, courts held that the publisher of a revised work based on a public domain work had a duty to *disclaim* any connection with the original publisher of the work, in order to avoid consumer confusion.

The action before the Court is yet another attempt to use trademark and unfair competition laws to prevent or impair the free use of a work which is alleged to be in the public domain.[2] This time, the former publisher seeks to *require* the use of the former publisher's name in connection with a revised edition of a public domain work. The former publisher seeks to place the petitioner in a "heads I win, tails you lose" situation, in which the petitioner not only faces trademark liability if it falsely attributes the revised edition to the previous publisher, but also faces trademark liability if it fails to attribute the revised edition to the previous publisher. This action should be seen for what it is: an attempt to use the Lanham Act to stifle and penalize the lawful use of a formerly copyrighted work that has entered the public domain.

[2] The Ninth Circuit's opinion remanded the case to the district court to determine whether the book upon which the Respondents' work was based was in fact in the public domain. This portion of the Ninth Circuit's opinion is not before the Court on this appeal.

ARGUMENT

I. After a Copyright Has Expired, Trademark Law May Not Be Used To Restrain Publication of the Work, or Use of the Title or the Author's Name.

Between 1880 and 1920, many former owners of expired copyrights, and authors of material not protected by copyright, attempted to use trademark or unfair competition law to prevent the free use of works in the public domain. An examination of these cases demonstrates that trademark law cannot be used to restrain the publication or use of a copyrighted work which has passed into the public domain.

In *The 'Mark Twain' Case (Clemens v. Belford, Clark & Co.)*, 14 F. 728 (C.C.N.D. Ill. 1883), the author Samuel Clemens claimed a trademark right in his well-known pen name, Mark Twain, and sought to enjoin the use of his name on a republication by the defendants of some of Twain's stories which were not protected by copyright. The judge remarked that "[t]his is the first attempt which has ever come under my notice to protect a writer's exclusive right to literary property under the law applicable to trade-marks." *Id.* at 731. The court sustained a demurrer to the complaint:

> The policy of the law in this country has been settled too long to be now considered doubtful, that the publication of literary matter without protection by copyright has dedicated such matter to the public, and the public are entitled to use it in such form as they may thereafter choose, and to quote, compile, or publish it as the writing of its author.

Id. at 732.

Eight years later, the Scottish publishers of the Encyclopedia Britannica sought to enjoin an American reprint of the Ninth Edition, which had been revised so that "in the place of certain articles of the original, copyrighted pursuant to the statutes of the United States, they have substituted other articles, to avoid infringement of the copyright." *Black v. Ehrich*, 44 F. 793, 794 (C.C.S.D.N.Y. 1891). The court denied the complainants' motion for a preliminary injunction:

> With the exception of the copyrighted articles, the entire literary matter of 'The Encyclopedia Britannica, Ninth Edition,' is public property in this country, at least, and a rival publisher has the legal right to make any use of it he sees fit. He may use any part of it, or all of it, *and call it by what name he prefers*.

Id. (emphasis added). The court remarked that "[i]f literary property could be protected upon the theory that the name by which it is christened is equivalent to a trademark, there would be no necessity for copyright laws." *Id.*

One year earlier, in *Merriam v. Holloway Pub. Co.*, 43 F. 450 (C.C.E.D. Mo. 1890), Associate Justice Samuel Miller heard a similar case involving a reprint of the 1847 Edition of Webster's Dictionary.[3] The copyright on the 1847 edition had expired on January 1, 1889. Justice Miller overruled a demurrer on the ground that the defendants were allegedly using a pictorial device which was alleged

[3] It should be noted that Justice Miller was the author of two of this Court's landmark 19th-Century cases on trademark and copyright, *The Trade-Mark Cases*, 100 U.S. 82 (1879) and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

to be a trademark of the plaintiff. However, in so doing, he expressly rejected the contention that Merriam had a trademark right in the name or content of "Webster's Dictionary":

> [I]t occurs to me that this proceeding is an attempt to establish the doctrine that a party who has had the copyright of a book until it has expired, may continue that monopoly indefinitely, under the pretense that it is protected by a trademark, or something of that sort. I do not believe in any such doctrine, nor do my associates. When a man takes out a copyright, for any of his writings or works, he impliedly agrees that, at the expiration of that copyright, such writings or works shall go to the public and become public property. . . . The copyright law gives an author or proprietor a monopoly of the sale of his writings for a definite period, but the grant of a monopoly implies that, after the monopoly has expired, the public shall be entitled ever afterward to the unrestricted use of the book.

Id. at 451. Other courts agreed that any publisher had the right to reprint and sell any editions of "Webster's Dictionary" which were in the public domain, so long as in doing so they did not falsely suggest that the reprints were more recent editions which were still under copyright. *See Merriam v. Famous Shoe & Clothing Co.*, 47 F. 411, 412 (C.C.E.D. Mo. 1891) ("I have no doubt that defendant is entitled to use the words 'Webster's Dictionary' to describe the work that it is engaged in publishing and selling. Those words were used to describe Webster's Dictionary of the edition of 1847, and, as the copyright on that edition has expired, it has now become public property. Any one may reprint that edition of the work, and entitle the reprint 'Webster's Dictionary.' "); *Merriam v. Texas Siftings*

Pub. Co., 49 F. 944, 948 (C.C.S.D.N.Y. 1892) ("Mere copies of the edition of 1847 and 1859 can be reproduced by a publisher, *over his own name*, provided he makes no misrepresentations to induce the public to believe that it is another book, the right to publish which is the exclusive property of the plaintiff.") (emphasis added). Neither court suggested that defendants would be subject to liability if they *declined* to use the name "Webster's Dictionary."

Both *Merriam v. Holloway* and *Merriam v. Famous Shoe* were quoted with approval by this Court in *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 191-93 (1896). In *Singer*, the plaintiff attempted to use trademark and unfair competition law to restrain the sale of sewing machines by the defendant, after the plaintiff's patent on the machine had expired. The Court held that "on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property." *Id.* at 185. It also held that the word "Singer" had become the generic name for the patented article, and that the defendant had the right to use the word "Singer," so long as in doing so it did not falsely suggest a connection with the plaintiffs. "It is plain that the infringement only resulted from the failure to plainly state, along with the use of that word, the source of manufacture." *Id.* at 203. At no time did the court suggest that the defendant would have been subject to liability if it had *declined* to use the name "Singer."

The *Singer* doctrine has been repeatedly reaffirmed by this Court. *See Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118-20 (1938) and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152 (1989). The *Kellogg* court emphasized that "[t]he only obligation resting upon Kellogg Company was to identify its own product lest it be

mistaken for that of the plaintiff." 305 U.S. at 119; *see also id.* at 120 ("Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff."). Such a requirement would have been nonsensical if Nabsico could have forced Kellogg to credit Nabisco as the original producer of Shredded Wheat.

Recent cases confirm the validity of these cases as applied to expired copyrights. In *Comedy III Prods. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000), the plaintiff attempted to claim a trademark right in the "name, the characters, the likeness, and overall 'act' of The Three Stooges," in order to prevent the use of a film clip of the Three Stooges which was in the public domain. The court held that "the Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity." *Id.* at 595. There was no suggestion that a different result would have obtained had the plaintiff sought to *force* New Line to give credit to the plaintiff for the use of a clip which was in the public domain.

II. After a Copyright Has Expired, Trademark Law May Require a Subsequent Publisher of a Revised Version of the Public Domain Work to Disclaim Any Connection With the Previous Publisher.

Despite the ruling in *Singer*, the Merriam company continued its campaign to prevent other publishers from using the designation "Webster's Dictionary" in connection with reprints or revisions of editions which had entered the public domain. Courts uniformly held that Merriam

could not use trademark law to prevent such use, because otherwise, "the policy of limiting the period of protection of copyrighted works would be frustrated, since dissemination of the work under a different title would seriously hamper the public distribution of the work."[4] *See, e.g., G. & C. Merriam Co. v. Straus*, 136 F. 477, 478 (C.C.S.D.N.Y. 1904) ("the bill is in part an attempt to protect the literary property in the dictionaries which became *publici juris* upon the expiration of the copyrights. This attempt must prove futile."); *G. & C. Merriam Co. v. Syndicate Pub. Co.*, 207 F. 515, 515-16 (2d Cir. 1913) (quoting District Court opinion of Learned Hand) ("Their pretension extends even to the point of forbidding the sale of any dictionary honestly compiled upon Webster's original sources. . . . I have not, however, the least doubt at the outset in overruling so extreme an assertion as this. It is quite clear that any honest compilation or abridgement at the present time of Webster's work is entitled to describe itself as such"), *aff'd*, 237 U.S. 618, 622 (1915) ("After the expiration of a copyright of that character, it is well settled that the further use of the name by which the publication was known and sold under the copyright cannot be acquired by registration as a trademark, for the name has become public property, and is not subject to such appropriation.").

However, in some instances courts were willing to require that the subsequent publisher publish a disclaimer

[4] *Maljack Prods., Inc. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996), *quoting* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.16, at 2-193 (1995). *See also Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002) ("A trademark in the title to this single book would compromise the policy of unrestricted use after expiration of the copyright").

that the revised edition was *not* published by the company which had previously published the copyrighted work. *See Ogilve v. G. & C. Merriam Co.*, 149 F. 858, 861 (C.C.D. Mass. 1907) ("The duty, therefore, is imposed upon such person of accompanying his publication with such indications as to the source of publication as will unmistakably inform the public that the book is published by himself, and not by the original publisher."), *aff'd as modified*, 159 F. 638, 642-43 (1st Cir. 1908) ("where another avails himself of the principle of public dedication, he must in good faith fully identify his production and clearly disassociate his work from the work of the one who has given significance to the name"), *on appeal after remand*, 170 F. 167, 168 (1st Cir. 1909) (requiring a disclaimer that "This dictionary is not published by the original publishers of Webster's Dictionary, or by their successors.").

In enforcing the First Circuit's decree against a corporate successor, the Sixth Circuit likewise emphasized that one who publishes a revised edition of a public domain work must take steps to *disclaim* any relationship with the previous publisher. *See G. & C. Merriam Co. v. Saalfield*, 190 F. 927, 933 (6th Cir. 1911) (defendant "did not unmistakably indicate that his publications were not the publications of . . . the complainant."), *on rehearing*, 198 F. 369, 375 (6th Cir. 1912) ("Defendant may not use the word at all, unless he accompanies it with the explanation; . . . he must 'unmistakably inform' the public that the article is of his production."). The disclaimer was required precisely because the revised edition was not the work of the original publisher; to suggest otherwise would be to deceive the public into thinking that the original publisher had in some way authorized the production of the revised work.

In a later proceeding in the same case, the Sixth Circuit drew a distinction between an exact reprint of a public domain work, and a revision of a public domain work. The former could be published *under the defendant's own name* without any disclaimer. *See Saalfield Pub. Co. v. G. & C. Merriam Co.*, 238 F. 1, 12 (6th Cir. 1917) ("The case against defendants, in this particular, stands solely upon a photographic reproduction of the 1847 book; a reproduction perfect in every detail, *save for the substitution of defendant's name on the title page as publisher* and save for an appendix. Upon this foundation there is scant room to support the theory of misleading the public.") (emphasis added). Recent cases confirm that all a subsequent publisher needs to do to avoid consumer confusion is to label the republished public domain work *with its own name. See Maljack Prods., Inc. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996) ("When a public domain work is copied, along with its title, there is little likelihood of confusion when even the most minimal steps are taken to distinguish the publisher of the original from that of the copy. The public is receiving just what it believes it is receiving – the work with which the title has become associated. The public is not only unharmed, it is unconfused."), *quoting* Leslie A. Kurtz, *Protection for Titles of Literary Works in the Public Domain*, 37 Rutgers L. Rev. 53, 77 (1984).[5]

[5] This case does not involve the question whether the Lanham Act requires that credit be given to the individual author of a literary work. Gen. Dwight D. Eisenhower, the author of the book upon which Respondents' television series was based, is not a party to this action.

III. Interpreting the Lanham Act to Require That the Publisher of a Revised Work Credit the Former Publisher or Distributor of a Public Domain Work Would Place Petitioner in a No-Win Situation.

In this case, petitioner Dastar produced and distributed a revised version of a television series, the copyright of which had expired and had not been renewed.[6] Under the cases cited above, if petitioner Dastar had listed the name of the original distributor, Twentieth-Century Fox,[7] or the names of SFM Entertainment and New Line Cinema, which had produced and distributed a home-video version of the television series, Dastar might have been liable under Section 43(a) of the Lanham Act for falsely suggesting an affiliation, connection or association with those entities as to the origin, sponsorship, or approval of the revised series. In order to avoid such liability, Dastar would have had to include a disclaimer "unmistakably informing" the public that the revised series had *not* been produced by Fox, SFM and New Line. Likewise, although

[6] The District Court held Dastar liable for infringement of the copyright in the book on which the TV series was based. The Ninth Circuit's opinion ordered a remand to determine whether the book was also in the public domain. It is undisputed that the author of the book, Gen. Dwight D. Eisenhower, never renewed the copyright in the book; what is disputed is whether the book was a work for hire, which would validate the purported renewal obtained by Doubleday. This portion of the Ninth Circuit's opinion is not before the Court on this appeal.

[7] Although Fox initiated and supervised the project, the television series was actually produced by Time, Inc., which is not a party to this action. *See* Finding of Fact No. 14 (reprinted in Petition for Certiorari, App. B at 9a). Thus, even if this Court were to interpret the Lanham Act to require that credit be given to the institutional "author" of an audiovisual work, Respondents would lack standing to sue.

Dastar had a right to use the original title of the television series if it had distributed the work without revision, had it used the original title on a revised copy of the work it might have been liable for false advertising, or it might have been required to include a disclaimer of any association between itself and the previous distributors of the series. Dastar sought to avoid such liability by publishing the revised public domain work under a different title and under its own name.

Respondents seek to place Petitioner in a "heads I win, tails you lose" situation.[8] If Dastar had chosen to publish a revised version of the public domain work under its original title, giving credit to Fox, SFM and New Line, those entities could have sued, claiming deception as to origin, sponsorship or approval of the revised version under Section 43(a) of the Lanham Act. Instead, Dastar truthfully published the revised version under its own name, as producer of the actual videotapes in question; and Fox, SFM and New Line have sued Dastar for *failing* to credit them as former distributors of the underlying public domain work. If such a cause of action is upheld, those who seek to publish public domain material will be placed in an untenable position. They risk liability if they use the name of the former owner of an expired copyright without permission, and they risk liability if they fail to use the name of the former owner of the expired copyright at all. Such an interpretation of the Lanham Act would essentially guarantee that publishers of public domain

[8] *Cf. Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 338 (1979) (Rehnquist, J., dissenting) (condemning "respondent's 'heads I win, tails you lose' theory of this litigation").

material would face a lawsuit and would deter such publishers from copying works in the public domain. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) ("Competition is deterred, however, not merely by successful suit but by the plausible threat of successful suit").

Under Respondents' interpretation of the Lanham Act, the only way Dastar could avoid liability would be to give credit to the former owners of the expired copyright (and their licensees), and simultaneously to include a disclaimer of any relationship between themselves and the former owners of the expired copyright (and their licensees). It is difficult to imagine how such a notice could be given without confusing the public in some manner.[9] In order to avoid such a result, the Lanham Act should be interpreted to permit the free use of materials in the public domain, without any duty to identify the former owner of the expired copyright.

IV. The Ninth Circuit's "Bodily Appropriation" Standard Is Based Entirely On the Amount of Copying That Has Occurred, and Is Therefore the Functional Equivalent of a Perpetual Copyright.

The Ninth Circuit's opinion in this case, following earlier Ninth Circuit precedent, imposes liability under Section 43(a) of the Lanham Act if the revised work is a

[9] The difficulties are multiplied when one considers all of the possible claims of credit that could be made for contributions to a television series, including directors, writers, actors, and technical crew.

"bodily appropriation" of the work in which the plaintiff asserts an interest. *Twentieth Century Fox Film Corp. v. Entertainment Distributing*, 34 Fed. Appx. 312, 314 (9th Cir.), *cert. granted sub nom. Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S.Ct. 816 (2002). This standard was expressly borrowed from copyright law:

> In the copyright context we have defined "bodily appropriation" as the "copying or unauthorized use of substantially the entire item." *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989). We consider this definition useful in the Lanham Act context, because . . . it recognizes that slight modifications of a product might cause customer confusion, while products which are merely generally similar will not.

Cleary v. News Corp., 30 F.3d 1255, 1261 (9th Cir. 1994). Under this standard, a Lanham Act case, which is supposed to focus on consumer confusion, instead becomes a case about whether copying has occurred, and the amount of copying that has occurred. *See* 34 Fed. Appx. at 314 ("Dastar copied substantially the entire *Crusade in Europe* series . . . Dastar's minimal changes to the series are not sufficient to avoid liability."); *see also* Petition for Cert., App. B, at 13a (Finding of Fact No. 40), App. C, at 45a (Uncontroverted Facts No. 22).

The Ninth Circuit's standard assumes without analysis that "bodily appropriation" (i.e., copying) *necessarily* results in consumer confusion. 34 Fed. Appx. at 314 (stating that "the 'bodily appropriation' test subsumes the less demanding 'consumer confusion' standard."). But when a previously copyrighted work enters the public domain, other producers have a right to reproduce, adapt

and distribute the work. A public domain work can legitimately have more than one source. To assume that consumer confusion *as to source* occurs whenever extensive copying occurs would negate the right of a subsequent producer to copy a public domain work without the permission of the former copyright owner.

The Second Circuit's *Waldman* standard is even more clearly the equivalent of a copyright infringement action. In *Waldman Publishing Group v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994), in order to determine whether Section 43(a) of the Lanham Act was violated, the court analyzed (1) whether there was an "original work of authorship" under Section 102(a) of the Copyright Act, *id.* at 781-82; (2) whether the works were "substantially similar" within the meaning of the Copyright Act, *id.* at 782-83; and (3) whether Waldman was the "author" of the work under the "work made for hire" doctrine of Section 201(a) of the Copyright Act, *id.* at 783-84. Although the court purported to require a showing of "consumer confusion" as a separate element, its entire analysis of "confusion" consists of a single sentence: "We concur with the district court's conclusion that consumers are likely to be confused by Landoll's misrepresentation as to the source of its books, even though the Landoll books are 'substantially similar' to but not 'bodily appropriations' of the Waldman books." *Id.* at 784.[10]

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[10] It is worth noting that other panels of the Second Circuit have implicitly rejected the *Waldman* standard in favor of a standard that requires an "affirmative act" of false representation beyond that implicit in any claim of copying. *See, e.g., Lipton v. Nature Co.*, 71 F.3d 464, 473 (2d Cir. 1995) ("We find that, as a matter of law, a false

(Continued on following page)

By equating Section 43(a) of the Lanham Act with standards developed to determine liability under the Copyright Act, and by assuming that consumer confusion exists whenever unattributed copying occurs, these Courts of Appeals have enabled an action to be maintained under the Lanham Act based entirely on the copying of a work in the public domain. Because liability under Section 43(a) of the Lanham Act is perpetual and is not limited in duration in any manner, such a cause of action would violate the Constitutional mandate that copyrights be granted only "for limited Times." U.S. Const., Art. I, § 8 cl. 8. While this Court recently held that Congress has the power to extend copyright terms, *Eldred v. Ashcroft*, 537 U.S. ___, 123 S.Ct. 769 (2003), both the majority and the dissent agreed that Congress may not do so indefinitely. *See Eldred*, 123 S.Ct. at 783 n.16 ("the Senate Report expressly acknowledged that the Constitution 'clearly precludes Congress from granting unlimited protection for copyrighted works.'"); *id.* at 800 (Stevens, J., dissenting) ("The express grant of a perpetual copyright would unquestionably violate the textual requirement that the authors' exclusive rights be only 'for limited Times.'"). Moreover, the majority

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copyright notice alone cannot constitute a false designation of origin within the meaning of § 43(a) of the Lanham Act."); *Kregos v. Associated Press*, 937 F.2d 700, 711 (2d Cir. 1991) ("we reject [Kregos'] attempt to convert all copyright claims to Lanham Act violations."). *See also Weber v. Geffen Records, Inc.*, 63 F. Supp. 2d 458, 464 (S.D.N.Y. 1999) ("plaintiff's Lanham Act claim is impermissible because it would essentially duplicate a Copyright Act claim."); *id.* at 463 ("Aware that nearly every copyright-based claim involves a charge of improper failure to credit a purported author, the Second Circuit has limited the extent to which a copyright-based claim may support a Lanham Act claim."); *accord, Armstrong v. Virgin Records, Ltd.*, 91 F. Supp. 2d 628, 633 (S.D.N.Y. 2000).

indicated that Congress' power extends only to "future works and existing works *not yet in the public domain*." 123 S.Ct. at 785 (emphasis added); *see also id.* at 799-800 (Stevens, J., dissenting) ("no one seriously contends that the Copyright/Patent Clause would authorize the grant of monopoly privileges for works *already* in the public domain solely to encourage their restoration.") (emphasis added). In addition, this Court has indicated that the Commerce Clause cannot be used to circumvent express limitations contained in other clauses. *See Railway Labor Executives' Assn. v. Gibbons*, 455 U.S. 457, 468-69 (1982) (Congress may not enact non-uniform bankruptcy laws under the Commerce Clause). Consequently, this Court should interpret the Lanham Act in a manner that does not cause it to come into conflict with the Constitutional limitation on patents and copyrights. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 35 (2001) (reserving the question of whether trade-dress protection for a product design covered by an expired patent would violate the Patent Clause, but noting that courts may not require competitors "to adopt a different design simply to avoid copying it."); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) ("The availability of [copyright and design patent] protections greatly reduces any harm to the producer that might ensue from our conclusion that a product design cannot be protected under § 43(a) without a showing of secondary meaning.").

CONCLUSION

Under either the Ninth Circuit's standard or the Second Circuit's standard, Section 43(a) of the Lanham Act operates as a substitute for copyright law, allowing the former copyright owner to assert a continuing interest in a previously copyrighted work which has entered the public domain. This Court should reject Respondents' attempt to use the Lanham Act to restrict and penalize the lawful use of a copyrighted work after its Constitutionally-mandated "limited time" has expired.

Respectfully submitted,

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